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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/730,232
Filing Date: December 05, 2000
Appellant(s): POLTORAK, ALEXANDER I.

Anatoly S. Weiser
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 29, 2006 appealing from the Office action mailed April 7, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

Claim 48 has been canceled in the Remarks submitted separately along with the Appeal Brief on June 29, 2006.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0091541	Lundberg	7-2002
2002/0095368	Tran	7-2002
6,879,990	Boyer et al.	4-2005
6,643,641	Snyder	11-2003

Fischer, Peter, Opening the Vault; Information Exchange, Technology Information Software magazine published April 1, 2000.

Kimball, Ralph, Fundamental Grains; Technology Information Intelligent Enterprise published on March 30, 1999.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the appellant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the appellant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 4, 20, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Lundberg (US 2002/0091541) (hereinafter referred to as Lundberg).

Referring to Claims 1 and 39:

Lundburg discloses a method and system for performing the method of searching intellectual property listings, comprising:

a) maintaining a user-interface site accessible by a plurality of users (Fig. 1);

b) establishing a connection to a plurality of third-party sources of intellectual property listings available for transaction ([0007] listings available for transacting are *records identified according to the criteria and presented to the user for approval to add to the portfolio*)(Fig. 1 (16) *source database of IP asset records*);

c) receiving from at least one of said plurality of users search criteria for searching said plurality of third-party sources of intellectual property listings (Fig. 2 (22) *enter search criteria*);

d) searching said plurality of third-party sources of intellectual property listings according to said search criteria (Fig. 2 (24) *search source database*);

e) presenting a resulting set of intellectual property listings to said at least one of said plurality of users (Fig. 2 (26) *display retrieved hits*); and

f) receiving from said at least one of said plurality of users an identification of those of said resulting set of intellectual property listings that are of interest to said at least one of said plurality of users (Fig. 2, (28-30) *reject unwanted hits; add wanted records to portfolio database*; pages 1-2 [0009]).

Referring to Claim 4:

Lundburg discloses a method further comprising the step of;

establishing contact between said at least one of said plurality of users and those of said plurality of third-party sources including those of said resulting set of intellectual property listings which are of interest to said at least one of said plurality of users (Figs. 1-2; *wide access network (16), such as the Internet*).

Referring to Claim 20:

Lundburg discloses a method wherein said user-interface site is a website (Figs. 1-2, [0007] *the system including HTML (web contains HTML files) or JAVA based browsers interacting through a server computer system through a wide access network such as the Internet*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claim 21 and 45-46 and 49-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tran (US 2002/0095368) (hereinafter referred to as Tran) in view of the article by Peter Fischer, *Opening the Vault; Information Exchange*; Technology Information Software Magazine published April 1, 2000 (hereinafter referred to as Fischer).

Referring to Claims 21, 45, and 49-53:

Tran discloses a method and system for performing the method of searching intellectual property listings online, comprising the steps of:

a) maintaining a user-interface site accessible by a plurality of users ([0007-0008] *a system supports trading of intellectual property (IP) with a user interface; Fig. 1 workstations 104-106*);

b) maintaining access to a predetermined set of third-party sources of intellectual property listings searchable online ([0009] *online trading is done through a network-based community in which buyers and sellers are brought together*; Figure 1; page 1 [0006] thru page 2 [0012]; page 2 [0014] *one or more client workstations 104-106 are connected to the network 102. Additionally, an Internet community 110 with one or more service providers, manufacturers, or marketers are connected; see also [0009] the portal provides the user with access to a network of IP lawyers and links the user to IP related business such as those who specialize in trading or mediating IP related issues*);

c) eliciting from each user search criteria for searching each of said third-party sources of intellectual property listings (page 1 [0006] thru page 2 [0012], page 3 [0017] *a user can simply search for desired assets*; [0022] *by having access to the member's IP interests, the portal can provide pre-screened, high-quality investment opportunities that match the investor's identified interest [0035] profile is used to create personalized pages for members by dynamically serving-up the content to each user utilizing*

dynamic HTML, among others [0007] to narrow the list, the inventor can specify one or more parameters or qualifications that the IP affiliates are required to have);

d) designating first and second memory storage areas for storage of intellectual property listings (page 1 [0006] thru page 2 [0012], page 4 [0023] *by offloading the storage on the server, the user minimizes the memory required on the client workstation – thus server memory and workstation memory*);

Tran does not specifically disclose reformatting the data or taking a snapshot of the data.

However, Fischer discloses formatting and reformatting data (page 3 Information Portals) and snapshots (page 6 last paragraph – Information snapshots)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the intellectual property management invention disclosed in Tran the information portals with XML repositories taught in Fisher so as to provide access to a wide array of corporate information in disparate databases and processing systems, wherein the data is gathered by the freezing of data at a predetermined point in time, thus giving a more accurate data set.

Referring to Claims 46:

Lundberg discloses a server computer ([0007] (12)).

3. Claims 22-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tran and Fisher as applied to claim 21 above, and further in view of Kimball, Ralph, Fundamental Grains; Technology Information Intelligent Enterprise published on March 30, 1999.

Referring to Claim 22:

Tran and Fisher disclose a method for searching intellectual property listings and via a portal with the ability to take snapshots. Tran nor Fisher explicitly disclose taking a new (updates) snapshot or comparing snapshots or updating snapshots.

However, Kimball discloses periodic snapshots and accumulating snapshots wherein the accumulating snapshot often combines the most recent volatile status with measures that accumulate from the beginning history (page 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the portal exchange and intellectual property trading invention disclosed in Tran and Fisher with the periodic snapshots disclosed in Kimball so as to get a complete picture of a business's database information.

Referring to Claim 23:

Tran discloses further comprising the steps of;

p) presenting a resulting set of intellectual property listings to said user (page 1 [0006] thru page 2 [[0012], [0045] *to narrow the list, the inventor can specify one or more parameters or qualifications that the IP affiliates are required to have*); and

q) eliciting from said user an identification of those intellectual property listings which are of interest (page 1 [0006] thru page 2 [0012], [0045] *to narrow the list, the*

inventor can specify one or more parameters or qualifications that the IP affiliates are required to have).

Referring to Claim 24:

Tran discloses a method further comprising the step of:

r) securing permission from each of said third-party sources of intellectual property listing allowing search of said third-party sources and presenting listings therefrom to said user (page 3 [0022] *the portal permits sellers to list assets for sale (ie, sellers choose to list assets or grant permission; portal provides access to members,*; page 4 [0024] *agreement*).

Referring to Claim 25:

Tran discloses a method further comprising the step of:

s) securing from each of said third-party sources of intellectual property listings a fee-sharing agreement in respect of any fees paid as a result of transactions arising out of contacts initially made through said user-interface site ([0017] *no fees are charged to the buyer for this service; [0020] the system assumes that the seller pays the transfer fee unless otherwise instructed; [0023] transaction usage fee, [0027] pre-determined annual membership fee and transaction fee; [0031] parties can negotiate fees relating to subsequent questions and/or work[0008] specialists can be paid on a commission basis).*

Referring to Claim 26:

Tran discloses a method further comprising the step of:

r) establishing contact between said user and the third party maintaining said intellectual property listings which are of interest (page 1 [0006] thru page 2 [0012] [0011] *portal provides the user with access to a network of IP lawyers for assistance and links the user with IP related businesses).*

Referring to Claim 27:

Tran does not disclose wherein the step of establishing contact includes the step of hyper-linking the user to the third party and transmitting to the third party a unique identifier identifying the user interface site.

However, the Examiner takes Official Notice that it is old and well known to provide hyperlinks to information as is evidenced by the PTO web page wherein hyperlinks are provided to link the user with the information the user is seeking. The Examiner also takes Official Notice that it is old and well known to transfer information via e-mails with hyperlinks (See Snyder US Patent 6,643,641).

However, this would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate hyperlinks into the intellectual property exchange disclosed in Tran since it is well known in the computer industry to use hyperlinks and unique identifiers so as to provide quick and convenient access to resources and to provide some indication of which interface the third party needs to respond to.

Referring to Claim 28:

Tran discloses a method further comprising the step of:

r) providing said user with a transaction manager ([0025] *Intellectual property assistant (assistant)) to facilitate a contemplated intellectual property transaction (page 1 [0006] thru page 2 [0012]; [0014], [0016], [0025]).*

Referring to Claim 29:

Tran discloses a method further comprising the step of:

s) said transaction manager contacting said third party maintaining the listings of the intellectual property being of interest to said user to facilitate said transaction (page 1 [0006] thru page 2 [0012], [0014], [0016] and [0028] *the search engine will use user profile to search web, store the results and relay information to user. The portal delivers focused IP contents to interested subscribers*).

Referring to Claims 30-32:

Tran discloses a method further comprising the steps of:

r) designating a memory for temporary storage of intellectual property listings matching said search criteria elicited from said user (page 1 [0006] thru page 2 [0012]) [0023] *a user can rent space on the server to enable him/her to download application software (applets) and /or data anytime and anywhere. By off loading the storage on the server, the user minimizes the memory required on the client workstation - server memory and workstation memory (page 1 [0006] thru page 2 [0012]) [see [0017] user can search for desired IP assets [0023] and [0025]*, and

t) collecting such intellectual property listings that match said criteria and storing said listings in said buffer memory (Figs 1, page 1 [0006] thru page 2 [0012] and [0023]

server memory enables complex operations to run and yet still ensures that user can access the application and related information anywhere anytime).

Tran does not disclose searching reformatted snapshots.

However, Fischer discloses a portal server that captures information snapshots in aggregate XML objects and wherein the portal server includes information connectors that allow users to access, retrieve, transform and update information stores in a variety of legacy systems and data sources (page 6 last two paragraphs).

The Examiner takes Official Notice that it is old and well known to search returned search data as is evidenced by an advance Goolge search or a search using the East database wherein searches are returned, information is displayed and searches can be performed on individual items of interest (see also Snyder US 6,643,641).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the portal exchange and intellectual property invention disclosed in Tran and Fischer the ability to search reformatted snapshots so that the user can refine a search result to find the exact data needed.

Referring to Claims 33-38:

Tran discloses a method further comprising the step of making available to said user analytical tools for valuation and analysis of the intellectual property ([0019] *electronic valuation module to estimate the value of the IP asset*), wherein said analytical tools are not available from the third party maintaining said intellectual property listings which are of interest, further comprising making available to said user

escrow services related to a contemplated intellectual property transaction)[0020] *Escrow button allows a buyer and seller to have a neutral third party watch over the title transfer process*), wherein said services are not available from the third party maintaining said listings of said intellectual property which are of interest, comprising the step of making available to said user title insurance covering the intellectual property which is the subject of a contemplated intellectual property transaction ([0022] *the portal offers forums providing articles, insights and information about insurance*), wherein said title insurance is not available from the third party maintaining intellectual property listings which are of interest, further comprising the step of making available to said user patent validity insurance covering the intellectual property which is the subject of a contemplated intellectual property transaction, wherein said patent validity insurance is not available from the third party maintaining said intellectual property listings which are of interest ([0022] *insurance*) further comprising the step of making available to said user consulting services related to a contemplated intellectual property transaction, further comprising the step of making available to said user legal services related to a contemplated intellectual property transaction [0030-0031[*the portal allows user to draft applications; a network of independent patent attorneys can perform checks*) (pages 2-3 [0016], [0019], pages 3-4 [0022]).

4. Claims 2-3, 5-7, 11-16, 19, 40-44, 47, 66-72, and 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundburg as applied to claims 1 and 39 and further in view of Tran.

Referring to Claim 2:

Lundberg does not discloses securing permissions.

However, Tran discloses a method further comprising the step of:

r) securing permission from each of said third-party sources of intellectual property listing allowing search of said third-party sources and presenting listings therefrom to said user (page 3 [0022] *the portal permits sellers to list assets for sale; portal provides access to members; page 4 [0024] agreement*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Tran with the method of Lundberg so as to facilitate the licensing and trading of IP assets between buyers who are looking to buy and sellers who actually want to sell.

Referring to Claim 3:

Tran discloses a method further comprising the step of:

s) securing from each of said third-party sources of intellectual property listings a fee-sharing agreement in respect of any fees paid as a result of transactions arising out of contacts initially made through said user-interface site ([0017] *no fees are charged to the buyer for this service; [0020] the system assumes that the seller pays the transfer fee unless otherwise instructed; [0023] transaction usage fee, [0027] pre-determined annual membership fee and transaction fee; [0031] parties can negotiate fees relating to*

subsequent questions and/or work; [0008] IP specialists can be paid on a commission basis).

Referring to Claims 11-16, 40-42, 86-88:

Lundburg discloses the invention as set forth in Claims 1 and 39.

Lundburg does not disclose the goods comprising business available for sale or merger, goods comprising venture capital, a transaction manager to facilitate a contemplated transaction or an Internet auction site.

However, Tran discloses wherein said goods comprise businesses available for sale, merger or acquisition, wherein said goods comprise venture capital available for investment [0009] and [0022] *portal provides access to non-IP resources including venture capitalists and analyst*), further comprising providing a transaction manager ([0025] *intellectual property assistant*) to facilitate a contemplated transaction between said user and the provider of said goods or services, wherein said third-party listings are comprised by Internet auction sites ([0006] *system supports purchasing or selling with a computerized bid, auction and sale system over a network such as the Internet; page 2 [0016] thru page 4 [0022]*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the trading method of Tran with intellectual property management method of Lundberg so as to enhance the licensing and trading of IP assets and to offer a quick-to-market, flexible business model that can be customized to fit the IP needs of any industry and to target technology without taking a long time to find a buyer for each available technology.

Referring to Claims 5:

Neither Lundberg nor Tran disclose wherein the step of establishing contact includes the step of hyper-linking the user to the third party and transmitting to the third party a unique identifier identifying the user interface site.

However, the Examiner takes Official Notice that it is old and well known to provide hyperlinks to information as is evidenced by the PTO web page wherein hyperlinks are provided to link the user with the information the user is seeking. The Examiner also takes Official Notice that it is old and well known to transfer information via e-mails with hyperlinks (See Snyder US Patent 6,643,641).

However, this would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate hyperlinks into the intellectual property exchange disclosed in Tran since it is well known in the computer industry to use hyperlinks and unique identifiers so as to provide quick and convenient access to resources and to provide some indication of which interface the third party needs to respond to.

Regarding Claim 6:

Tran discloses a method further comprising the step of:

r) providing said user with a transaction manager ([0025] *Intellectual property assistant (assistant)) to facilitate a contemplated intellectual property transaction (page 1 [0006] thru page 2 [0012]; [0014], [0016], [0025])*.

Referring to Claim 7:

Tran discloses a method further comprising the step of:

s) said transaction manager contacting said third party maintaining the listings of the intellectual property being of interest to said user to facilitate said transaction (page 1 [0006] thru page 2 [0012], [0014], [0016] and [0028] *the search engine will use user profile to search web, store the results and relay information to user. The portal delivers focused IP contents to interested subscribers*).

Referring to Claims 19 and 43:

Tran discloses the third party sources as Internet auction sites ([0006] *auction and sale system over a network such as the Internet*).

Referring to Claims 44 and 47:

Tran discloses wherein the user interface is a website ([0016] *user interface is a web-based user interface) and third party user interface sites comprise Internet auction sites {0006] auction and sale system over the Internet*)

Referring to Claims 66-72:

Tran discloses method and system for searching intellectual property listings online, comprising:

a) making available to a user a software application for installment on said user's computing device, said application comprising instructions to (page 4 [0023]):

i. execute a query as specified by said user (page 4 [0023] and [0029] *search engines use the user profiles to search the web; profile information including company affiliations, occupations, etc [0010]*);

ii. search predetermined Internet sites and exchanges (page 4[0023] and [0045] *the process can select an IP affiliate for marketing the IP asset. In this process, upon*

registration with the portal, the inventor or IP owner is shown a list or directory of IP affiliates);

iii. display search results to said user via said terminal, said search results comprising one or more intellectual property listings ([0045] *IP owner is shown a list or directory*); and

iv. enabling said user to indicate a listing of interest (page1 [0006] thru page 2 [0012], *[0010] profile contains areas of interests [0045] to narrow the list the inventor can specify one or more parameters or qualifications that the IP affiliates are required to have)*; and

b) assigning a transaction manager (*intellectual property assistant ([0025])* to contact said user and the source of said listing to facilitate a desired transaction related to said listing of interest (*[0016] and [0029] portal delivers focused IP contents to interested subscribers).*

5. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundberg in view of Boyer et al (US 6,879,990) (hereinafter referred to as Boyer).

Referring to Claim 8:

Lundburg discloses a method wherein the step of searching said plurality of third-party sources includes the steps of:

a) designating a buffer memory for temporary storage of intellectual property listings matching said search criteria (a memory is inherent in the system (Figures 1-2, page 1 [0009] *IP database is searched for records matching the one or more criteria.*

Client computer displays to the user on the client computer a list of records found in the search (temporary storage of results). User can reject the selected records in the list. Non rejected records are added to user portfolio database (permanent storage); and

c) searching through the intellectual property listings of said each of said plurality of third-party sources for matches with said respective reformatted search criteria (Figs. 1-2 (22) *search source database.*

d) displaying a list of retrieved hits (Figure 2 (22))

Lundberg does not disclose reformatting the search criteria, searching through the intellectual property listings of a plurality of third party sources with the respective reformatted search criteria, collecting the listing that match the reformatted criteria.

However, Boyer discloses reformatting said search criteria according to requirements of each of said plurality of third-party sources of intellectual property listings, searching through the intellectual property listings of said each of said plurality of third-party sources for matches with said respective reformatted search criteria and collecting such intellectual property listings that match said reformatted criteria and storing said listings in said buffer memory (col. 9, lines 11-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the intellectual property management invention disclosed in Lundberg with the ability to reformat searches so as to be able access information over the Internet irrespective of the computing platforms of the various databases.

Furthermore, the Examiner takes Official Notice that portals are old and well known. For example, Sequoia, DataChannel, Plumtreeserve as gateways to the

Internet by using XML to separate data from the presentation layer, freeing up the portal application to use the same data and information and present it in a variety of formats.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate into Lunberg the ability to format and reformat data so that data can be easily aggregated and organized form across disparate organizations.

Referring to Claim 9:

Boyer discloses a method further comprising the step of:

reformatting said intellectual property listings stored in said buffer memory in a predetermined format prior to presentation thereof to said at least one of said plurality of users (col. 9, lines 10-34).

Referring to Claim 10:

Lundburg discloses a method further comprising the step of:

reordering (order again) said intellectual property listings stored in said buffer memory according to predefined criteria prior to presentation thereof to said at least one of said plurality of users (Figs. 1-2 [0009] *the client computer displays to the user on the client computer a list or records found in the search; the set can be groomed (by deletion of unwanted records selected in the query) to form a part or all of the desired user portfolio database of IP assets records. Additional records can be added by specifying them one at a time or another group can be selected by executing additional searches using different search criteria* [0007].

6. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundberg as applied to claim 1 above, and further in view of Fischer and Kimball.

Referring to Claim 17:

Lundberg and Fisher disclose a method for searching intellectual property listings and via a portal with the ability to take snapshots. Lundberg nor Fisher explicitly disclose taking a new (updates) snapshot or comparing snapshots or updating snapshots.

However, Kimball discloses periodic snapshots and accumulating snapshots wherein the accumulating snapshot often combines the most recent volatile status with measures that accumulate from the beginning history (page 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the portal exchange and intellectual property trading invention disclosed in Tran and Fisher with the periodic snapshots disclosed in Kimball so as to get a complete picture of a business's database information.

Referring to Claim 18:

Lundburg does not disclose searching reformatted snapshots.

However, Fischer discloses a portal server that captures information snapshots in aggregate XML objects and wherein the portal server includes information connectors that allow users to access, retrieve, transform and update information stores in a variety of legacy systems and data sources (page 6 last two paragraphs).

The Examiner takes Official Notice that it is old and well known to search returned search data as is evidenced by an advance Goolge search or a search using

the East database wherein searches are returned, information is displayed and searches can be performed on individual items of interest (see also Snyder US 6,643,641).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the portal exchange and intellectual property invention disclosed in Tran and Fischer the ability to search reformatted snapshots so that the user can refine a search result to find the exact data needed.

(10) Response to Argument

A. Rejection of Claim 1 as Being Anticipated by Lundberg.

The appellant directs the arguments as to claim 1 to the following terminology contained in claim 1, ***available for transacting***.

Claim 1 has the following limitation:

establishing a connection to a plurality of third-party sources of intellectual property listings ***available for transacting***.

The Examiner cites Lundberg as disclosing the limitation.

The Examiner submits that Lundberg discloses the following:

establishing a connection to a plurality of third-party sources of intellectual property listings available for transaction ([0007] listings available for transacting are *records identified according to the criteria and presented to the user for approval to add to the portfolio*)(Fig. 1 (16) *source database of IP asset records*).

As submitted by the Examiner in the arguments section of the Office action mailed on April 7, 2006, the language *available for transacting* is a broad concept.

The Examiner provided the following definition:

The Microsoft Computer Dictionary defines the term transaction as:

> A discrete activity within a computer system such as an entry of a customer order or an update of an inventory item. Transactions are usually associated with database management, order entry, and other online systems.

Lundberg discloses an Internet based method and system for organizing records into user portfolios by retrieving or selecting a set of IP asset records from a source database of IP records from various sources, including, for example, Patent Office, i.e., USPTO, EPO, or any other country's patent and trademark offices [0007]. A user operating a client computer can assess and build a user portfolio database of records representative of IP assets. Lundberg discloses that the portfolio can be assembled by several techniques, these techniques include retrieving or selecting a set of IP asset records from a source database of IP asset records. The Examiner asserts that this is a discrete activity within a computer system. The Examiner further asserts that the IP asset records gathered from various patent and trademark offices are third party sources of intellectual property listing available to be retrieved or selected, thus available for transacting.

Appellant is also directed to paragraphs [0002], [0003] and [0007] of Lundberg wherein Lundberg discloses:

> [0002] Information concerning intellectual property assets such as patents, trademarks and copyrights ***is typically stored in databases that can be searched and queried.*** For example, ***databases representative of these assets are now widely available on the Internet, and much of the basic data***

can be obtained free of charge. **These public databases, for example the Internet database of patents and trademarks sponsored by the United States Patent & Trademark Office or the European Patent Office, contain records** representative of a large number of the patents or trademarks that are processed by these organizations.

[0003] In managing or working with intellectual property assets, it is often desirable to maintain a database of IP assets that for example belong to a certain organization or group of organizations, typically termed a "portfolio." A portfolio may be organized according to ownership rights or other attributes such as a group of patents or trademarks having a relationship to one another, or simply a group of IP assets that a user desires to group together for the purpose of management, manipulation, analysis or other objectives. ***While Internet databases of IP assets allow access to and operation on individual assets such as a single patent, they have not provided a system for conveniently assembling a plurality of IP asset records from a database into smaller groups such as but not limited to a portfolio of IP asset records representative of patents or trademarks or other IP owned by a particular organization.*** Further, there has not been provided a means for assembly such portfolios conveniently and then managing them using the assembled records.

[0007] Referring now to FIGS. 1 and 2 there is illustrated an Internet-based method for **organizing records** into user portfolios. As shown in FIG. 1, the system 10 includes a plurality of client computers 12 such as personal computers, workstations or Internet appliances that include HTML or JAVA based browsers or other software capable of interacting with a server computer system 14, through a wide access network 16, such as the Internet in one example embodiment. Using the method of FIG. 2, a user operating a client computer 12 **can access and build a user portfolio database of records representative of IP assets** such as patents, trademarks or other IP assets. As will be illustrated below, the portfolio can be assembled by several different techniques all managed from a client computer user interface, which is an HTML or JAVA based language in one example embodiment. **These techniques include retrieving or selecting a set of IP asset records from a source database of IP asset records 16 (FIG. 1)** for example including all patents or trademarks issued or handled by an organization such as the United States Patent & Trademark Office, or the European Patent Office, or any other country's patent and trademark offices. This set can then be groomed (by deletion of unwanted records selected in the query) to form a part or all of the desired user portfolio database of IP asset records. **Additional records can be added to this database by specifying them one at a time, or another group can be selected by executing an additional search for a group of additional records using different search criteria**. For example, a first group of records

based on a first owner can be retrieved and groomed and added to the user portfolio. Another group could similarly be retrieved and added to the portfolio. In addition, records can be added to the database one at a time, for example specified by patent number or trademark registration number. Moreover, in another embodiment, records which are added to the source database or databases can be automatically identified by recurrent searches of the source database. These records can be identified according to one or more additional criteria, and staged and presented to the user for approval to add to the portfolio, or simply added to the portfolio automatically. **By this mechanism, a user can assemble a portfolio containing records of past issued patents or trademarks and also automatically have this portfolio updated.**

The appellant argues, on page 22, that *the appellant specification unequivocally uses "transacting" in the sense of exchanging or transferring property.*

In response to appellant's argument that the references fail to show certain transacting as being exchanging or transferring property, it is noted that this feature upon which appellant relies (i.e., ***exchanging or transferring property***) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, claims must be given their broadest reasonable interpretation consistent with the supporting description without reading limitations into the claim (MPEP 2111). A reasonable interpretation of the claim language is the one found in the Microsoft Computer Dictionary. Appellant has not claimed exchanging or transferring property in the claims.

Moreover, appellant has not defined in appellant's disclosure that the term "transacting" specifically means *exchanging or transferring goods.*

Where appellant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the appellant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). Even going outside the computer field, the Merriam Webster Online Dictionary defines the term "transact" to mean:

transact

One entry found for **transact**.

Main Entry: **trans·act**
Pronunciation: tran-'zakt, tran(t)-'sakt
Function: *verb*
Etymology: Latin *transactus,* past participle of *transigere* to drive through, complete, transact, from *trans-* + *agere* to drive, do -- more at AGENT
intransitive verb **:** to carry on business
transitive verb
1 : to carry to completion <*transact* a sale>
2 : to carry on the operation or management of **:** DO <*transact* business>

Thus, it is not clear, as asserted by appellant, that the term transacting specifically means exchanging or transferring goods. Therefore, since the appellant has not defined "transacting" in the specification, the Examiner asserts the Examiner's interpretation of *transacting* as being a discrete activity within a computer system such as an entry of a customer order or an update of an inventory item, wherein the transacting is associated with database management, i.e., retrieving or selecting information, is a reasonable interpretation.

Therefore, the Examiner submits that Lundberg discloses establishing a connection to a plurality of third party sources of intellectual property listings available for transacting. The Examiner asserts that the IP asset records gathered from various patent and trademark offices are third party sources of intellectual property listing which are available to be retrieved or selected, thus available for transacting.

B. Rejection of Claim 39 as being anticipated by Lundberg.

Appellant states that independent claim 39 was rejected as being anticipated by Lundberg based on the same reasoning as was applied to claim 1. Appellant further states that claim 39 recites limitations similar to those discussed above in relation to claim 1 and should be patentable.

As for claim 39, since the appellant has failed to provide any arguments, the Examiner directs the Board to the discussion above in to claim 1.

C. Rejection of Claim 21 as Being Unpatentable over Tran and Fischer.

The appellant points to a typographical error made by the Examiner in the rejection.

> Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the intellectual property management invention disclosed in *Lundberg* the information portals with XML repositories taught in Fisher so as to provide access to a wide array of corporate information in disparate databases and processing systems, wherein the data is gathered by the freezing of data at a predetermined point in time, thus giving a more accurate data set.

The Examiner asserts that this is a typographic error. The paragraph should read:

> Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the intellectual property management invention disclosed in *Tran* the information portals with XML repositories taught in Fisher so as to provide access to a wide array of corporate information in disparate databases and processing systems, wherein the data is gathered by the freezing of data at a predetermined point in time, thus giving a more accurate data set.

Claim 21 was rejected under the following heading:

Claim 21 and 45-46 and 49-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tran (US 2002/0095368) (hereinafter referred to as Tran) in view of the article by Peter Fischer, *Opening the Vault; Information exchange*; Technology Information Software Magazine published April 1, 2000 (hereinafter referred to as Fischer).

Therefore, while the Examiner apologizes for the typographical error, the Examiner asserts that the references used to reject claim 21 are clearly set forth.

The appellant states that the purported motivation to combine given in the Office Action speaks about incorporating "XML repositories" into Lundberg, not into Tran and that therefore the Office Action does not offer any motivation to combine Tran with Fischer.

Claim 21 was rejected using Tran in view of Fischer. Lundberg was not used as prior art in this rejection. As stated above, the mention of Lundberg was a typographical

error that has been corrected. The Examiner asserts that this should be apparent to the appellant.

The appellant then states that the purported rationale to combine is deficient in other ways as well. Appellant states that a person skilled in the art would not have a need "to provide access to a wide array of corporate information in disparate databases and processing systems," because Tran apparently does not use "disparate databases and processing systems". Appellant further states that Tran discloses one system with intellectual property listings, not multiple systems. Appellant argues that with a single system, there appears to be no obvious need to reformat data, because the data need not be in different formats.

The appellant has completely misinterpreted Tran. Paragraph [0009] discloses:

> [0009] On-line trading is done through a **network-based community** in which buyers and sellers are brought together in an efficient format to buy and sell intellectual property and other assets. The system permits sellers to list assets for sale, buyers to bid on assets of interest and all users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy-to-use online service that is available 24-hours-a-day, seven-days-a-week. The system overcomes the inefficiencies associated with traditional person-to-person trading by facilitating buyers and sellers meeting, listing items for sale, exchanging information, interacting with each other and, ultimately, consummating transactions. Through such a trading place, buyers can access a significantly broader selection of assets to purchase and sellers have the opportunity to sell their assets efficiently to a broader base of buyers. The techniques support real time and interactive auctions that allows bidders place bids in real time and compete with other bidders around the world using the Internet. The techniques allow customer bids to be automatically increased as necessary up to the maximum amount specified, so bids can be raised and auctions won even when bidders are away from their computers. In one aspect, the techniques provide a single window to a user's most commonly used desktop information. The window **provides a portal** that helps the user protect new ideas or concepts in an economical, efficient and fast manner by providing the user with access to a network of IP lawyers for assistance in finalizing the applications. **The portal also links the user with IP related**

businesses such as those who specialize in trading or mediating IP related issues. **The portal also provides access to non-IP resources**, including venture capitalists and analysts who track evolving competition and market places. The portal remains with users the entire time they are online and can automatically update the users on any competing products or any new patents or trademarks granted in their areas of interest. Once users are logged-in, **the portal** remains in full view throughout the session, including when they are waiting for pages to download, navigating the Internet and even engaging in non-browsing activities such as sending or receiving e-mail.

Paragraph [0016] discloses:

[0016] **The server 100 supports an intellectual property portal that provides a single point of integration, access, and navigation through the multiple enterprise systems and information sources** facing knowledge workers operating the client workstations 104-106. In an exemplary user interface to support IP asset trading, the user interface is a web-based user interface. The user interface allows a user to sign-on or sign-off the system.

Paragraphs [0022] and [0023] disclose:

[0022] Yet another service supported by the portal is on-line trading of IP assets. **By communicating through a wide area network such as the Internet, the portal supports a network-based community** in which buyers and sellers are brought together **in an efficient format** to buy and sell intellectual property and other assets. The portal permits sellers to list assets for sale, buyers to bid on assets of interest and all users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy-to-use online service that is available 24-hours-a-day, seven-days-a-week. Through such an IP trading portal, **IP buyers can access a significantly broader selection of IP assets to purchase and sellers have the opportunity to sell their IP assets efficiently to a broader base of buyers. The portal overcomes the inefficiencies associated with traditional person-to-person trading by facilitating buyers and sellers meeting, listing items for sale, exchanging information, interacting with each other and, ultimately, consummating transactions.** Additionally, the portal offers forums providing focused articles, valuable insights, questions and answers, and value-added information about seed and venture financing and startup related issues, including accounting and consulting, commercial banking, insurance, law, and venture capital. The portal can connect savvy Internet investors with IP owners. By having access to the member's IP interests, the portal can provide pre-screened, high-quality investment opportunities that match the investor's

identified interests. The portal thus finds and adds value to good deals, allows investors to invest from seed financing right through to the IPO, and facilitates the hand off to top tier underwriters for IPO. Additionally, members of the portal have access to a broad community of investors focused on the cutting edge of high technology, enabling them to work together as they identify and qualify investment opportunities for IP or other corporate assets.

[0023] Other services can be supported as well. For example, a user can rent space on the server to enable him/her to download application software (applets) and/or data--anytime and anywhere. By off-loading the storage on the server, the user minimizes the memory required on the client workstation 104-106, thus enabling complex operations to run on minimal computers such as handheld computers and yet still ensures that he/she can access the application and related information anywhere anytime. Another service is On-line Software Distribution/Rental Service. **The portal can distribute its software and other software companies from its server. Additionally, the portal can rent the software** so that the user pays only for the actual usage of the software.

Paragraph [0027] discloses:

The **portal incorporates data from multiple sources in multiple formats** and organizes it into a single, easy-to-use menu.

Paragraph [0029] discloses:

[0029] **The portal has access to IP search engines that continuously search the web and identify information that is of interest to its users.** These search engines will use the user profiles to search the web and store the results in the user folders. This information is also relayed to the users using the assistant. The portal delivers focused IP contents to interested subscribers and indirectly drives these subscribers and their businesses to innovate.

Paragraph [0035] discloses:

[0035] Based on this information, the server 100 can create personalized pages for members by dynamically serving-up the content to each user utilizing **dynamic HTML, among others.**

Appellant argues a person skilled in the art would not have a need to "provide access to a wide array of corporate information in disparate databases and processing

systems" because Tran apparently doe not use "disparate databases and processing systems. Appellant further states that Tran discloses one system with intellectual property listings, not multiple systems and that as a single system, there appears to be no obvious need to reformat data, because the data need not be in different formats.

Tran discloses multiple formats and multiple source [0027]. Tran is directed to an intellectual property portal that provides a single point of integration, access, and navigation through the multiple enterprise systems and information sources. As disclosed in Fischer, a portal aggregates and organizes information across disparate organizations within its portal. Most portals use XML as the standard that will enable them to provide access and integration across the disparate applications. XML, unlike HTML, separates the data from the presentation layer, freeing up the portal application to use the same data and information and presents it in a variety of formats. XML does the federated searches since all the data is XML and can be searched. Information portals typically contain XML repositories (memory) that store XML templates. The data is transformed into XML (formatted) and then reformatted. Fischer also discloses information snapshots being captured as XML objects. Therefore, any portal will format and reformat data. Since Tran discloses a portal which incorporates data from multiple sources in multiple formats [0027], Tran formats and reformats data.

The article, *Successful ports marry structured, unstructured data,* I-S Analyzer printed on July 1, 2000, supplied to the appellant with the Office Action mailed on April 7, 2006, teaches that portals can aggregate and organize information from across disparate organizations within its portal.

Tran discloses portals. Fischer discloses that an organization typically has multiple sources of information in disparate databases and processing systems. Fischer teaches that information is exchanged using a variety of proprietary approaches, such as database extracts, file transfers, and batch updates. Business are required to support numerous formats to enable information exchange (page 1, 5th paragraph).

The Examiner submits that appellant's argument that a person skilled in the art would not have a need to "provide access to a wide array of corporate information in disparate databases and processing systems" because *Tran apparently does not use "disparate databases and processing systems" but instead discloses one system with intellectual property listings, not multiple systems and that as a single system, there appears to be no obvious need to reformat data, because the data need not be in different formats*, is without merit, especially in light of the appellant's own disclosure. Appellant identifies appellant's invention as follows:

> A system and database for facilitating a one-stop shopping aggregation portal site on the Internet and a software application for searching, listing, marketing and transacting goods and services, especially intellectual property. With such method, system and database, information available on all online exchange and auction sites on the Internet, as well information from other sources, is consolidated in a ***single***, one-stop aggregation portal site using a uniform user-friendly interface.

In paragraph [0016], as set forth above, Tran discloses:

> [0016] The server 100 supports an intellectual property portal that provides a ***single point*** of integration, access, and navigation through the multiple enterprise systems and information sources

The appellant further argues that the Office Action does not explain why "freezing of data at a predetermined point in time" would result in "giving a more accurate data set." The appellant states that Office Action does not cite any reference and does not take Official Notice of any fact in support of this conclusion. The appellant further states that the Office Action simply states this as a conclusion of fact and the appellant disagrees with this conclusion and that a prima facie case of obviousness cannot be founded on such a bare, unsupported conclusion.

The motivational statement read as follows:

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the intellectual property management invention disclosed in Tran [Lundberg] the information portals with XML repositories taught in Fisher so as to provide access to a wide array of corporate information in disparate databases and processing systems, wherein the data is gathered by the freezing of data at a predetermined point in time, thus giving a more accurate data set.

It appears that appellant is arguing against the Examiner's motivation to combine Fischer with Tran as to the limitation of taking a snapshot of intellectual property listing.

Fischer discloses information snapshots being captured in aggregate XML objects, which are templates that define the XML record structure for stored information (page 6). The appellant states that the Examiner did not take Official Notice of the motivation. The Examiner submits that Official Notice is taken as to a claim limitation that is old and well known. The Examiner submits that one does not take Official Notice in the motivational statement.

In response to appellant's argument that there is no suggestion to combine Fischer with Tran for the limitation of taking a snapshot, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation was taken from the knowledge generally available to one of ordinary skill in the art. As evidence of this, appellant is directed to Kimball, Ralph, Fundamental Grains; Technology Information provided to the appellant in the Office action mailed on April 7, 2006 wherein Kimball gives a detailed discussion of snapshots.

Wikipedia found on www.onelook.com dictionary defines snapshot as:

Snapshot (computer storage)

From Wikipedia, the free encyclopedia

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In computer file systems, a **snapshot** is a copy of a set of files and directories as they were at a particular point in the past. Snapshots are useful for avoiding version skew when backing up volatile data sets, such as tables in a busy database or the folder store of a busy mail server.

Some file systems, such as WAFL, internally track old versions of files and make snapshots available through a special namespace. Others, like NTFS, provide an operating system API for accessing file histories.

Some Unix systems (including Linux and HP-UX) may also have snapshot-capable logical volume managers. These implement copy-on-write on entire block devices by copying changed blocks—just before they are to be overwritten—to other storage, thus preserving a self-consistent past image of the block device. Filesystems on this image can later be mounted as if it were on read-only media. Block-level snapshotting is almost always less space-efficient than direct file system support for snapshots. Read-write snapshots are sometimes called branching snapshots, because they implicitly create diverging versions of their data.
Shadow paging and write ahead logging are similar snapshot-like mechanisms used internally by many databases to implement transactions.
The concept of a snapshot can also be applied to data structures held only in memory, for example in the implementation of software transactional memory. A "version" of a persistent data structure is effectively a snapshot.

Thus, the Examiner asserts that a computer snapshot, just like a camera snapshot, captures a view in a moment in time, whether it be data or a landscape or movements of a person.

The appellant argues that neither Tran and nor Fischer disclose or suggest maintaining access to a predetermined set of ***third-party sources of intellectual property listings.*** The appellant states that the Office Action cited Tran's Figure 1, the entire summary section (paragraphs [0006] through [0012]), and paragraph [0014] for this teaching. The appellant states that the cited portions nor elsewhere does Tran mention more than a single source of intellectual property listings, and that even the single source disclosed in Tran is not a third-party source, but Tran's system itself.

The Examiner respectfully disagrees with the appellant arguments. The Examiner set forth the following as to this limitation:

b) maintaining access to a predetermined set of third-party sources of intellectual property listings searchable online ([0009] *online trading is done through a network-based community in which buyers and sellers are brought together*; Figure 1; page 1 [0006] thru page 2 [0012]; page 2 [0014] *one or more client workstations 104-106 are connected to the network 102. Additionally, an Internet community 110 with one or more service providers, manufacturers, or marketers are connected; see also [0009] the portal provides the user with access to a network of IP lawyers and links the user to IP related business such as those who specialize in trading or mediating IP related issues*);

The Examiner also directs the appellant to the following paragraphs:

[0006] Systems and methods cost-effectively are disclosed to facilitate and enhance the licensing and trading of IP assets. **The system supports purchasing or selling of intellectual property related products and services with a computerized bid, auction and sale system over a network such as the Internet. The techniques provide IP owners with access to an open market for trading IP.** The techniques support a service-based auction network of branded, online auctions to individuals, businesses, or business units. The techniques offer a quick-to-market, flexible business model that can be customized to fit the IP needs of any industry and target technology.

[0009] On-line trading is done through **a network-based community** in which buyers and sellers are brought together in an efficient format to buy and sell intellectual property and other assets. The system permits sellers to list assets for sale, buyers to bid on assets of interest and all users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy-to-use online service that is available 24-hours-a-day, seven-days-a-week. The system overcomes the inefficiencies associated with traditional person-to-person trading by facilitating buyers and sellers meeting, listing items for sale, exchanging information, interacting with each other and, ultimately, consummating transactions. **Through such a trading place, buyers**

can access a significantly broader selection of assets to purchase and sellers have the opportunity to sell their assets efficiently to a broader base of buyers. The techniques support real time and interactive auctions that allows bidders place bids in real time and compete with other bidders around the world using the Internet. The techniques allow customer bids to be automatically increased as necessary up to the maximum amount specified, so bids can be raised and auctions won even when bidders are away from their computers. In one aspect, the techniques provide a single window to a user's most commonly used desktop information. The window provides a portal that helps the user protect new ideas or concepts in an economical, efficient and fast manner by providing the user with access to a network of IP lawyers for assistance in finalizing the applications. **The portal also links the user with IP related businesses such as those who specialize in trading or mediating IP related issues.** The portal also provides access to non-IP resources, including venture capitalists and analysts who track evolving competition and market places. The portal remains with users the entire time they are online and can automatically update the users on any competing products or any new patents or trademarks granted in their areas of interest. Once users are logged-in, the portal remains in full view throughout the session, including when they are waiting for pages to download, navigating the Internet and even engaging in non-browsing activities such as sending or receiving e-mail.

[0016] **The server 100 supports an intellectual property portal that provides a single point of integration, access, and navigation through the multiple enterprise systems and information sources** facing knowledge workers operating the client workstations 104-106. In an exemplary user interface to support IP asset trading, the user interface is a web-based user interface.

[0022] **Yet another service supported by the portal is on-line trading of IP assets. By communicating through a wide area network such as the Internet, the portal supports a network-based community in which buyers and sellers are brought together in an efficient format to buy and sell intellectual property and other assets. The portal permits sellers to list assets for sale, buyers to bid on assets of interest and all users to browse through listed items** in a fully-automated, topically-arranged, intuitive and easy-to-use online service that is available 24-hours-a-day, seven-days-a-week. **Through such an IP trading portal, IP buyers can access a significantly broader selection of IP assets to purchase and sellers have the opportunity to sell their IP assets efficiently to a broader base of buyers. The portal overcomes the inefficiencies associated with traditional person-to-person trading by facilitating buyers and sellers meeting, listing items for sale, exchanging information, interacting with each other and, ultimately, consummating transactions.** Additionally, the portal offers forums providing

> focused articles, valuable insights, questions and answers, and value-added information about seed and venture financing and startup related issues, including accounting and consulting, commercial banking, insurance, law, and venture capital. **The portal can connect savvy Internet investors with IP owners.** By having access to the member's IP interests, the portal can provide pre-screened, high-quality investment opportunities that match the investor's identified interests. The portal thus finds and adds value to good deals, allows investors to invest from seed financing right through to the IPO, and facilitates the hand off to top tier underwriters for IPO. Additionally, members of the portal have access to a broad community of investors focused on the cutting edge of high technology, enabling them to work together as they identify and qualify investment opportunities for IP or other corporate assets.
>
> [0029] **The portal has access to IP search engines that continuously search the web and identify information that is of interest to its users. These search engines will use the user profiles to search the web and store the results in the user folders. This information is also relayed to the users using the assistant. The portal delivers focused IP contents to interested subscribers and indirectly drives these subscribers and their businesses to innovate.**

Thus, the Examiner asserts that Tran discloses maintaining access to a predetermined set of third party sources of intellectual property listings (a community of buyers and sellers of IP assets would be considered to be third party sources of intellectual property listings). Tran discloses a portal which permits sellers to list assets for sale, buyers to bid on assets of interest and all users to browse through listed items. Tran discloses that through such an IP trading portal, IP buyers can access a significantly broader selection of IP assets to purchase and sellers have the opportunity to sell their IP assets efficiently to a broader base of buyers.

Appellant argues again on page 24 of the Appeal Brief that Tran does not disclose or suggest that persons or entities have listings of intellectual property.

The Examiner directs the appellant again to paragraph [0023] wherein the following is disclosed:

> [0022] **Yet another service supported by the portal is on-line trading of IP assets. By communicating through a wide area network such as the Internet, the portal supports a network-based community in which buyers and sellers are brought together in an efficient format to buy and sell intellectual property and other assets. The portal permits sellers to list assets for sale, buyers to bid on assets of interest and all users to browse through listed items** in a fully-automated, topically-arranged, intuitive and easy-to-use online service that is available 24-hours-a-day, seven-days-a-week. **Through such an IP trading portal, IP buyers can access a significantly broader selection of IP assets to purchase and sellers have the opportunity to sell their IP assets efficiently to a broader base of buyers. The portal overcomes the inefficiencies associated with traditional person-to-person trading by facilitating buyers and sellers meeting, listing items for sale, exchanging information, interacting with each other and, ultimately, consummating transactions.**

Tran discloses a portal for the on-line trading of IP assets wherein sellers list assets for sale. Thus, Tran discloses persons and entities having listings of intellectual property.

As for the appellant statement that *a third-party source of intellectual property listings must have (1) multiple listings of (2) intellectual property from (3) a third party,* it is noted that the features upon which appellant relies (i.e., **multiple listings of intellectual property** from a third party are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant then states that even if Tran does discloses or suggest the limitation of *persons or entities having listings of intellectual property,* Tran does not disclose or suggest access to the listing is provided to the entities. Appellant states that Tran only provides links.

Tran provides access, not just links. Appellant is directed to the following :

[0022] Yet another service supported by the portal is on-line trading of **IP assets.** By communicating through a wide area network such as the Internet, the portal supports a network-based community in which buyers and sellers are brought together in an efficient format to buy and sell intellectual property and other assets. The **portal permits sellers to list assets for sale, buyers to bid on assets of interest and all users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy-to-use online service** that is available 24-hours-a-day, seven-days-a-week. Through such an IP trading portal, IP buyers can **access** a significantly broader selection of IP assets to purchase and sellers have the opportunity to sell their IP assets efficiently to a broader base of buyers. The portal overcomes the inefficiencies associated with traditional person-to-person trading by **facilitating buyers and sellers meeting, listing items for sale, exchanging information, interacting with each other and, ultimately, consummating transactions.**

The appellant states the following on page 24 of the specification:

The undersigned attorney has perused Tran's disclosure, but has not been able to identify any suggestion of multiple third-party sources of intellectual property listings. We submit that Tran is devoid of such teaching or suggestion. Tran discloses a single system and the disclosed system is not a third-party system.

The Examiner respectfully disagrees with this assertion.

Claims 21 discloses maintaining a user interface site accessible by a plurality of users (disclosed in paragraphs [0007-0008] and [0016] of Tran - user interface is a web-based user interface) and maintaining access to a predetermined set of third-party sources of intellectual property listings searchable online ([0022] The **portal permits sellers to list assets for sale, buyers to bid on assets of interest and all users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy-to-use online service;** a community of buyers and sellers of IP assets would be considered to be third party sources of intellectual property listings**)**. Therefore, it is not

clear what the appellant is arguing by the statement *Tran discloses a single system and the disclosed system is not a third party system.*

Appellant identifies appellant's invention as follows:

> A system and database for facilitating a one-stop shopping aggregation portal site on the Internet and a software application for searching, listing, marketing and transacting goods and services, especially intellectual property. With such method, system and database, information available on all online exchange and auction sites on the Internet, as well information from other sources, is consolidated in a single, one-stop aggregation portal site using a uniform user-friendly interface (page 12, last paragraph onto page 13).

Appellant also identifies the invention as:

> In accordance with the principles of the present invention, the above and other objectives are realized in a method, system and database for facilitating a one-stop shopping aggregation portal site on the Internet and a software application for searching, listing, marketing and transacting goods and services, especially intellectual property. With such method, system and database, information available on all online exchange and auction sites on the Internet, as well information from other sources, is consolidated in a **single, one-stop aggregation portal site using a uniform user-friendly interface** (page 9).

In paragraph [0016], as set forth above, Tran discloses:

> [0016] The server 100 supports an intellectual property portal that provides a **single point of integration, access, and navigation through the multiple enterprise systems and information sources.**

Thus, appellant too discloses a single point or portal. The Examiner asserts, as set forth above, that the portal allows access to third party source, i.e., buyers, sellers, etc.

On page 25, the appellant argues that Tran does not disclose XML. In response to appellant's arguments against the Tran reference individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The appellant argues that even if the use of XML inherently lead to reformatting, it would still not follow that Tran's system inherently reformats. Appellant is directed to the following paragraphs of Tran wherein Tran discloses:

Paragraph [0027] discloses:

> The **portal incorporates data from multiple sources in multiple formats** and organizes it into a single, easy-to-use menu.

Tran, in combination with Fischer, discloses a portal which incorporates data from multiple sources in multiple formats. Tran, in combination with Fischer, disclose formatting, reformatting, XML and snapshots.

D. Rejection of Claim 45 as Being Unpatentable Over Tran and Fischer.

The appellant states that independent claim 45 was rejected as unpatentable over Tran and Fischer, based on the same reasoning as was applied to claim 21. The appellant then argues that the Office action failed to provide a proper motivation.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation came from the Fischer reference and from knowledge generally available to one of ordinary skill in the art.

The motivation states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate into the intellectual property management invention disclosed in Lundberg the information portals with XML repositories taught in Fisher so as to provide access to a wide array of corporate information in disparate databases and processing systems (Fischer page 1), wherein the data is gathered by the freezing of data at a predetermined point in time, thus giving a more accurate data set (knowledge generally available to one of ordinary skill in the art).

The appellant then argues that the references do not disclose or suggest multiple third-party sources with lists of offered items as recited in the preamble of claim 45 wherein the preamble is directed to a ***system for searching*** for a desired one of many items offered over the Internet, wherein said items are present on third-party interface sites in multiple listings. In response to appellant's arguments, although the Examiner asserts that Tran discloses multiple third-party sources with lists of offered items (IP assets), the recitation is generally not given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but,

instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The appellant states that the references do not disclose or suggest multiple third party sources with lists of offered items.

As set forth above under the discussion of claim 21, Tran discloses:

> [0022] Yet another service supported by the portal is on-line trading of IP assets. By communicating through a wide area network such as the Internet, the portal supports a network-based community in which buyers and sellers are brought together in an efficient format to buy and sell intellectual property and other assets. **The portal permits sellers to list assets for sale,** buyers to bid on assets of interest and all users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy-to-use online service that is available 24-hours-a-day, seven-days-a-week. **Through such an IP trading portal, IP buyers can access a significantly broader selection of IP assets to purchase and sellers have the opportunity to sell their IP assets efficiently to a broader base of buyers.** The portal overcomes the inefficiencies associated with traditional person-to-person trading **by facilitating buyers and sellers meeting, listing items for sale, exchanging information, interacting with each other and, ultimately, consummating transactions.** Additionally, the portal offers forums providing focused articles, valuable insights, questions and answers, and value-added information about seed and venture financing and startup related issues, including accounting and consulting, commercial banking, insurance, law, and venture capital. The portal can connect savvy Internet investors with IP owners. By having access to the member's IP interests, the portal can provide pre-screened, high-quality investment opportunities that match the investor's identified interests. The portal thus finds and adds value to good deals, allows investors to invest from seed financing right through to the IPO, and facilitates the hand off to top tier underwriters for IPO. Additionally, members of the portal have access to a broad community of investors focused on the cutting edge of high technology, enabling them to work together as they identify and qualify investment opportunities for IP or other corporate assets.

Thus, Tran discloses multiple third-party sources, buyers and sellers, with list of offered items.

E. Rejection of Claim 49 as Being Unpatentable Over Tran and Fischer

The Examiner notes that appellant provides no new arguments as to Claim 49, stating that the limitations are similar to those discussed in claim 21, and directs the Board to the discussion under claim 21.

F. Rejection of Claims 50-53 as Being Unpatentable Over Tran and Fischer

The Examiner notes that appellant provides no new arguments as to Claims 50-53, stating that the limitations are similar to those discussed in claim 21, and directs the Board to the discussion under claim 21.

G. Rejection of Claims 66 and 70 as Being Unpatentable Over Lundberg and Tran

Referring to Claims 66-72:

Tran discloses method and system for searching intellectual property listings online, comprising:

a) making available to a user a software application for installment on said user's computing device, said application comprising instructions to (page 4 [0023]):

i. execute a query as specified by said user (page 4 [0023] and [0029] *search engines use the user profiles to search the web; profile information including company affiliations, occupations, etc [0010]*);

ii. search predetermined Internet sites and exchanges (page 4[0023] and [0045] *the process can select an IP affiliate for marketing the IP asset. In this process, upon*

registration with the portal, the inventor or IP owner is shown a list or directory of IP affiliates);

iii. display search results to said user via said terminal, said search results comprising one or more intellectual property listings ([0045] *IP owner is shown a list or directory*); and

iv. enabling said user to indicate a listing of interest (page1 [0006] thru page 2 [0012], *[0010] profile contains areas of interests [0045] to narrow the list the inventor can specify one or more parameters or qualifications that the IP affiliates are required to have)*; and

b) assigning a transaction manager (*intellectual property assistant ([0025])* to contact said user and the source of said listing to facilitate a desired transaction related to said listing of interest (*[0016] and [0029] portal delivers focused IP contents to interested subscribers).*

The appellant points out in footnote 1 at the bottom of page 27, that Lundberg was not used in the discussion of claims 66 and 70. Examiner submits that the Examiner erred in grouping claims 66-70 under the rejection as set forth:

Claims 2-3, 5-7, 11-16, 19, 40-44, 47, 66-72, and 86-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundburg as applied to claims 1 and 39 and further in view of Tran.

Claims 66 and 70 are independent claims and Lundberg was not used in the rejection, as set forth above. Thus, the proper rejection of claims 66 and 70 would have

been a 102(e) rejection of claims 66 and 70 as being anticipated by Tran since claims 66 and 70 have been rejected with only Tran used as prior art.

The appellant's argues that in rejection claims 66 and 70, that the Office action reasoned that the limitation of instructions that execute a query as specified by said user" is not found in the cited portions of Tran.

The Examiner cited the following:

i. execute a query as specified by said user (page 4 [0023] and [0029] *search engines use the user profiles to search the web; profile information including company affiliations, occupations, etc [0010]*);

The appellant argues that "profile information" is not a query.

Paragraph [0029] discloses:

> [0029] The portal has access to IP search engines that continuously search the web and identify information that is of interest to its users. **These search engines will use the user profiles to search the web** and store the results in the user folders. This information is also relayed to the users using the assistant. **The portal delivers focused IP contents to interested subscribers and indirectly drives these subscribers and their businesses to innovate.**

Paragraph [0007] identifies the invention as:

> [0008] Implementations of the system can include one or more of the following. The system offers one of more of the following: **a trade IP user interface to accept a request to trade an IP asset; a buy IP user interface to accept a request to buy an IP asset; a sell IP user interface to accept a request to sell an IP asset; a register IP user interface to accept a request to register an IP asset;** an appraise IP user interface to accept a request to appraise an IP asset; and an escrow IP user interface to accept a request to place an IP into escrow service. The system can provide an IP chat-room. The system can provide a network adapted to electronically link IP specialists to provide value added services to the patent application. **The system can match IP specialists such as attorneys, draftsmen, IP marketers and inventors on request.** The IP specialists can be paid on a commission basis. An automated patent drafting system can be used to generate a patent application having a

> required sequence. The system can provide an online platform for selling and buying patentable ideas or pending patent applications and where parties can list and search for applications that are about to be abandoned. The network is the Internet and wherein clients access the system using a browser. A patent information management (PIM) system can be used to display information for a user to manage the user's IP and to communicate with other users relating to the IP. The PIM provides information on pending activities relating to an IP asset and wherein the user can drill down to get additional information on the IP asset.
>
> [0011] In another aspect, the system provides an online platform for selling and buying ideas without patent protection or ideas with pending patent applications that otherwise are ready to be abandoned. that are about to be abandoned **The system allows parties to list and search for applications** simply because the inventors or owners of the application do not have financial resources to pursue the prosecution of these applications for financial or other reasons. The system provides a win-win solution for the inventors and for investors who see potential revenue opportunities.
>
> [0017] The operations of exemplary buttons are discussed next. First, the Buy button allows a user to bid on a particular asset. In this embodiment, there are no fees charged to the buyer for this service and the seller pays fees. **A user can simply search for desired IP assets** and submit an offer using an interactive form. Upon receiving an offer, the system forwards it to the seller and notifies the buying party whether the offer has been accepted, rejected, or if there is a counteroffer. If the offer is accepted, the buyer will be mailed a purchase contract and detailed escrow instructions to sign, similar to those used in a real estate or business opportunity transaction.

Thus, the Examiner submits that by the search engines using the users profiles to search, the profiles containing the user's personalized area of interest [0035], the search then identifying and delivering information of interest to the users or focused IP contents, is executing a query as specified by said user. Paragraph [0022] states that by having access to the member's IP interests, the portal can provide pre-screened, high-quality investment opportunities that match the investor's identified interest.

Furthermore, the appellant is directed to paragraph [0017], wherein Tran discloses that the system allows parties to search for desired IP assets.

The appellant states that claim 68, which depends for claim 66, recites prompting the user for personal information and that ***this may include a profile***. The Examiner asserts that this is not how claim 68 reads.

Claims 68 reads:

The method of claim 66, further comprising prompting said user for personal information, said information used by said software application to automatically register said user with a plurality of Internet auctions and exchanges.

In response to appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the features upon which appellant relies (i.e., profiles) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Tran discloses a personal profile, which would inherently include personal information as set forth in paragraphs [0024-0025] and [0035] which is used to register the user.

The Examiner asserts that the profile can contain the query, i.e., the user's areas of interest and thus still meet the appellant's claim limitation. Furthermore, the appellant has not identified that the personal information includes a profile in the specification. A search of the appellant's original disclosure does not produce the word "profile".

Paragraph [0013] of appellant's specification discloses:

> Alternatively, the user may be asked to provide certain personal information, such as the user's first and last name, the name of the company, address, phone number and e-mail address, which is used by the application software to automatically register the user with a plurality of Internet auctions and exchanges.

Therefore, for the appellant to now assert that the personal information may include a profile, the Examiner asserts that appellant does not have disclosure for this.

Rejection of Claim 3 as Being Unpatentable Over Lundberg and Tran

Claim 3 reads *securing from each of said plurality of third-party sources of intellectual property listing a fee-sharing agreement.*

Appellant argues that the references do not disclose or suggest a fee-sharing agreement. The Examiner respectfully disagrees with this assertion.

Tran discloses securing from each of said third-party sources of intellectual property listings a fee-sharing agreement in respect of any fees paid as a result of transactions arising out of contacts initially made through said user-interface site ([0017] *no fees are charged to the buyer for this service; [0020] the system assumes that the seller pays the transfer fee unless otherwise instructed; [0023] transaction usage fee, [0027] pre-determined annual membership fee and transaction fee; [0031] parties can negotiate fees relating to subsequent questions and/or work; [0008] IP specialists can be paid on a commission basis)*

Tran further discloses in paragraph [0020] that *typically, the system assumes that the seller pays the transfer fee unless otherwise instructed.* Thus, the Examiner asserts

that this is an agreement - the seller pays the transfer fees unless the seller instructs otherwise.

The appellant then argues that the listings in Lundberg are records in official patent and trademark databases, such as the USPTO. The appellant then states that the USPTO and other patent and trademark offices are not known to enter into fee sharing agreements.

First, the listing of the patent and trademark offices in paragraph [0007] are exemplary, not inclusive. Lundberg states that *the techniques include retrieving or selecting a set of IP asset records from a source database of IP asset records,* ***for example including*** *all patents or trademarks issued or handled by an organization such as the USPTO.*

Furthermore, the appellant is directed to paragraph [0014] of Lundberg wherein Lundberg discloses:

> [0014] According to one example embodiment, **some of the records added to the user portfolio database correspond to records of IP assets maintained in a source database such as the USPTO's database, while other records in the user portfolio database pertain to IP assets that are not represented in such databases such as a pending U.S. patent application.** Furthermore, according to one example embodiment, a record found in a source database during a recurring update search, such as a newly issued U.S. patent record, may correspond to a record in the user portfolio database that is representative of the filed application for that patent. In such a case, the serial/application number of the application as may be stored in the user portfolio record can be matched to the serial/application number of the issued patent, and the record of the application can be updated to indicate the patent is issued, such that duplicate records are avoided.

Furthermore, Lundberg discloses accounts and users sharing an account as set forth below:

[0020] According to yet another example embodiment 70 illustrated in FIG. 6, a user can order electronic or paper copies of documents pertaining to one or more of the IP assets in the user portfolio database, using a client computer 72. A user can optionally request on the client computer that electronic copies of documents pertaining to one or more **IP assets in the user portfolio be made available for access by the user or group of users sharing an account 84.** One additional embodiment of the invention provides for displaying to the user on the client computer a user activated indicia associated with one or more IP assets in the user portfolio database that allows the user to view an electronic image of a document associated with an IP asset in the user portfolio database. Further, according to one embodiment, the electronic copies are owned by the user and can be downloaded by the user, and are kept in PDF format. According to one example embodiment, the server computer system includes one or more computing or storage devices, and such devices may be located together or in different locations. The computing device can be, without limitation, a personal computer or a workstation computer or an Internet appliance.

[0021] According to one example embodiment, the server computer system 4 uses JAVA and/or HTML-based languages to interact with a client computer 7, with the user portfolio databases being maintained on the server computer system 14. The system 14 provides for displaying on the client computer the controls required to accomplish the functions specified above, and in particular controls that provide that a user can create, build, display and use a user portfolio database. In one example embodiment, **the system 14 provides an account for each user which is password protected. Within each account, a user can create and maintain one or more user portfolio databases.** For example, a user may create a patent user portfolio database of patents owned by the user's company, and a separate trademark user portfolio database of trademarks owned by the user's company.

The Examiner asserts that Lundberg does not preclude fee agreements. The Examiner further asserts that Tran discloses a fee-sharing agreement and that the fee-sharing agreement disclosed in Tran, when combined with Lundberg, is workable.

I. Rejection of Claim 10 as Being Unpatentable Over Lundberg and Tran

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lundberg in view of Boyer et al (US 6,879,990) (hereinafter referred to as Boyer).

Appellant argues that Lundberg does not disclose the step of *reordering said intellectual property listing stored in said buffer memory according to predefined criteria prior to presentation thereof to said at least one of said users.*

Claim 10, as well as claim 9, depend on claim 8, wherein the Examiner set forth the following rejection:

Lundburg discloses a method wherein the step of searching said plurality of third-party sources includes the steps of:

a) designating a buffer memory for temporary storage of intellectual property listings matching said search criteria (a memory is inherent in the system (Figures 1-2, page 1 [0009] *IP database is searched for records matching the one or more criteria. Client computer displays to the user on the client computer a list of records found in the search (temporary storage of results). User can reject the selected records in the list. Non rejected records are added to user portfolio database (permanent storage)*; and

c) searching through the intellectual property listings of said each of said plurality of third-party sources for matches with said respective reformatted search criteria (Figs. 1-2 (22) *search source database.*

d) displaying a list of retrieved hits (Figure 2 (22))

Lundberg does not disclose reformatting the search criteria, searching through the intellectual property listings of a plurality of third party sources with the respective reformatted search criteria, collecting the listing that match the reformatted criteria.

However, Boyer discloses reformatting said search criteria according to requirements of each of said plurality of third-party sources of intellectual property listings, searching through the intellectual property listings of said each of said plurality of third-party sources for matches with said respective reformatted search criteria and collecting such intellectual property listings that match said reformatted criteria and storing said listings in said buffer memory (col. 9, lines 11-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the intellectual property management invention disclosed in Lundberg with the ability to reformat searches so as to be able access information over the Internet irrespective of the computing platforms of the various databases.

Furthermore, the Examiner takes Official Notice that portals are old and well known. For example, Sequoia, DataChannel, Plumtreeserve as gateways to the Internet by using XML to separate data from the presentation layer, freeing up the portal application to use the same data and information and present it in a variety of formats.

Therefore, it would have been obvious to one of ordinary skill in the art to incorporate into Lunberg the ability to format and reformat data so that data can be easily aggregated and organized form across disparate organizations.

Referring to Claim 9:

Boyer discloses a method further comprising the step of:

reformatting said intellectual property listings stored in said buffer memory in a predetermined format prior to presentation thereof to said at least one of said plurality of users (col. 9, lines 10-34).

Referring to Claim 10:

Lundburg discloses a method further comprising the step of:

reordering (order again) said intellectual property listings stored in said buffer memory according to predefined criteria prior to presentation thereof to said at least one of said plurality of users (Figs. 1-2 [0009] *the client computer displays to the user on the client computer a list or records found in the search; the set can be groomed (by deletion of unwanted records selected in the query) to form a part or all of the desired user portfolio database of IP assets records. Additional records can be added by specifying them one at a time or another group can be selected by executing additional searches using different search criteria* [0007].

As to claim 10, Appellant argues, that Lundberg does not disclose the step of **reordering said intellectual property listings stored in said buffer memory according to predefined criteria prior to presentation thereof to at least one of said plurality of users.**

The Examiner respectfully notes the following:

(1) Although appellant's specifications contain several mentions of order and reorder, appellant provides no definition for the terms found in the claims.

(2) Since appellant has provided no explicit definition for the term "reordering", the Examiner relies on the term's ordinary meaning and broadest reasonable interpretation.

E-Pass Technologies, Inc. v. 3Com Corporation, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003).

Appellant discloses the following in appellant's specification:

[0004]... If several matches are found, the resulting matches may be ranked in a predetermined order and displayed on the user's computer screen or otherwise conveyed to the user.

[0030] ... The intellectual property listings stored in buffer memory 32 may be reordered by compiler 24 according to a predefined criteria. The method terminates at step 364.

Claim 10 reads as follows:

10. The method of claim 8, further comprising the step of:

reordering said intellectual property listings stored in said buffer memory according to predefined criteria prior to presentation thereof to said at least one of said plurality of users.

The Examiner asserts that predetermined criteria encompasses criteria set forth by the user prior to the search (i.e., criteria determined by the user prior to the search).

Tan discloses the following:

[0007] Referring now to FIGS. 1 and 2 there is illustrated an Internet-based method for organizing records into user portfolios. As shown in FIG. 1, the system 10 includes a plurality of client computers 12 such as personal computers, workstations or Internet appliances that include HTML or JAVA based browsers or other software capable of interacting with a server computer system 14, through a wide access network 16, such as the Internet in one example embodiment. Using the method of FIG. 2, a user operating a client computer 12 can access and build a user portfolio database of records representative of IP assets such as patents, trademarks or other IP assets. As will be illustrated below, the portfolio can be assembled by several different techniques all managed from a client computer user interface, which is an HTML or JAVA based language in one example embodiment. These techniques include retrieving or selecting a set of IP asset records from a source database of IP asset records 16 (FIG. 1) for example including all patents or trademarks issued or handled by an organization such as the United States Patent & Trademark Office, or the European Patent Office, or any other country's patent and

> trademark offices. This set can then be groomed (by deletion of unwanted records selected in the query) to form a part or all of the desired user portfolio database of IP asset records. Additional records can be added to this database by specifying them one at a time, or another group can be selected by executing an additional ***search for a group of additional records using different search criteria.*** For example, a first group of records based on a first owner can be retrieved and groomed and added to the user portfolio. Another group could similarly be retrieved and added to the portfolio. In addition, records can be added to the database one at a time, for example specified by patent number or trademark registration number. Moreover, in another embodiment, records which are added to the source database or databases can be automatically identified by recurrent searches of the source database. ***These records can be identified according to one or more additional criteria, and staged and presented to the user for approval to add to the portfolio, or simply added to the portfolio automatically.*** By this mechanism, a user can assemble a portfolio containing records of past issued patents or trademarks and also automatically have this portfolio updated.

Please note the alternative, where the information ***is not presented to a user*** :

...simply added to the portfolio automatically...

By this mechanism, a ***user can assemble*** a portfolio containing records of past issued patents or trademarks and also automatically have this portfolio updated.

Paragraph [0009] of Lundberg discloses:

> [0009] Referring now to FIG. 2, a method according to one example embodiment 20 is illustrated in more detail. ***A user enters*** into a client computer on the Internet ***one or more first criteria for a search of an IP database*** (22)....The source IP database is then searched for records matching the one or more criteria (24). The client computer displays to the user on the client computer a list of records found in the search (26).

The Examiner asserts this section discloses records - searched, and rendered according to predefined criteria prior to presentation.

...The user can optionally reject, using the client computer, selected records in the list, for example by checking off records from a list. (28). The non-rejected records are added to a user portfolio database (30). According to one embodiment, this search and groom operations are done ***in one session***

The Examiner asserts that this is a reiterative process of search, format and display according to predetermined criteria prior to presentation to the user.

[0011] The ***user can also specify,*** ..., one or more additional search criteria for an IP database

This is appellant's predetermined criteria prior to presentation to the user.

[...searched...] on a recurring basis on at least some of the days following the original search [...according to predetermined criteria prior to presentation to the user...]..***These search results are displayed to the user***

The Examiner asserts that the results are displayed after further searching and reordering...according to predetermined criteria prior to presentation...etc]

...for example each time a user logs on to the system, and the user can optionally reject selected records in the list using the client computer (40) [...after the list has been presented to the user..]

...[list is] later pared from the database using a **grooming function** [from a list that was put together according to predefined..., a user ... delete unwanted records from the portfolio 46.

non-rejected records being added to the user portfolio database (42). Such additional records can be alternatively added to the database automatically 44 and later pared from the database using a grooming function that allows a user at any time to delete unwanted records from the portfolio 46.

Lundberg also discloses in paragraph [0019]:

[0019] According to yet another example embodiment 70 shown in FIG. 5, data analysis or processing regarding one or more IP assets in the user portfolio database can be performed, either on the server computer system, or the client

computer 72. **Such analysis might, for example, determine the number of patents held in a particular art area, or the number of patents to expire in a given year.**

This is re-ordering by sorting and re-organizing intellectual property listing according to a pre-defined criteria (particular art area, number of patents to expire) prior to presentation.

Thus, the Examiner asserts that Lundberg discloses the limitation of claim 8.

J. Rejection of Claim 88 as Being Unpatentable Over Lundberg and Tran.

Claim 88 is directed to *the method of claim 1, wherein the a plurality of third-party sources of intellectual property listing available for transacting comprises third-party sources selected from the group consisting of exchange site and an auction site.*

Claim 88 was rejected as follows:

Referring to Claims 11-16, 40-42, 86-88:

Lundburg discloses the invention as set forth in Claims 1 and 39.

Lundburg does not disclose the goods comprising business available for sale or merger, goods comprising venture capital, transaction manager to facilitate a contemplated transaction or ***an Internet auction site***.

However, Tran discloses wherein said goods comprise businesses available for sale, merger or acquisition, wherein said goods comprise venture capital available for investment [0009] and [0022] *portal provides access to non-IP resources including venture capitalists and analyst*), further comprising providing a transaction manager ([0025] *intellectual property assistant*) to facilitate a contemplated transaction between

said user and the provider of said goods or services, wherein said third-party listings are comprised by Internet auction sites ([0006] *system supports purchasing or selling with a computerized bid, auction and sale system over a network such as the Internet; page 2 [0016] thru page 4 [0022]*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the trading method of Tran with intellectual property management method of Lundberg so as to enhance the licensing and trading of IP assets and to offer a quick-to-market, flexible business model that can be customized to fit the IP needs of any industry and to target technology without taking a long time to find a buyer for each available technology.

The Examiner asserts that any of the sites disclosed in Tran can fall under the broad concept of an exchange site since appellant has not specifically defined what an exchange site is in the specification. Appellant refers to an exchange and auction site throughout the specification, without specifically defining the term "exchange site".

Furthermore, Tran discloses the following:

> [0006] Systems and methods cost-effectively are disclosed to facilitate and enhance the licensing and **trading (the Examiner asserts that trading is exchanging)** of IP assets. The system supports purchasing or selling of intellectual property related products and services with **a computerized bid, auction and sale system** over a network such as the Internet. The techniques provide IP owners with access to an open market for trading IP. The techniques **support a service-based auction network (the Examiner asserts that this is an auction site**) of branded, online auctions to individuals, businesses, or business units. The techniques offer a quick-to-market, flexible business model that can be customized to fit the IP needs of any industry and target technology.
>
> Paragraph [0009] discloses real time interactive auctions.

Thus, the Examiner asserts that Tran discloses third party sources selected from the group consisting of exchange cites (trading) and auction sites and thus the limitations of claim 88 have been met.

K. Rejections of Remaining Dependent Claims

The Examiner notes that appellant has not provided any arguments under this heading other than to make the statement that dependent claims not specifically addressed in the above arguments should be patentable at least for the reasons discussed in relation to their base and intervening claims.

Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Note Regarding Official Notices:

The appellant submitted a separate remarks section filed the same day as the Appeal Brief wherein appellant makes a cursory argument regarding Official Notice. The appellant simply states that the Examiner took Official Notice of several alleged facts and cited certain items in support. Appellant states that the cited items speak for themselves. Appellant states that references to Google and East do not provide dates. Appellant states that appellant traverses to the extent that the scope of the Official Notices goes beyond the references that properly fall out within prior art.

A "traverse" is a denial of an opposing party's allegations of fact.[1] The Examiner respectfully submits that appellants' arguments and comments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret appellants' arguments and comments as constituting a traverse, appellants' arguments and comments do not appear to constitute an adequate traverse because appellant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

The appellant then states that appellant, in particular, wishes to point out that whatever the Examiner's definition of a "portal", appellant believes that the portal claimed in the application is new. Appellant states that appellant submitted a declaration to that effect at the time the application was filed.

First, appellant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The appellant simply states that appellant's portal is new.

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[1] Definition of Traverse, Black's Law Dictionary, "In common law pleading, a traverse signifies a denial."

Secondly, the only Declaration submitted by appellant is the inventor declaration (37 CFR 1.63) submitted on December 5, 2000.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jan Mooneyham
Primary Examiner
Art Unit 3629

Conferees:

John Weiss, Supervisory Patent Examiner, Art Unit 3629

Dean Nguyen, Primary Examiner, Art Unit 3629